APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,709	03/29/2004	Timothy J. Throndson	9411-3	1356

20792   7590   07/07/2010
MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER
GLASS, RUSSELL S

ART UNIT	PAPER NUMBER
3687	

MAIL DATE	DELIVERY MODE
07/07/2010	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/811,709
Filing Date: March 29, 2004
Appellant(s): THRONDSON ET AL.

D. Scott Moore
For Appellant

EXAMINER'S ANSWER

(1) Procedural History

This answer is in response to the appeal brief filed 4/1/2010 appealing from the

Office action mailed 9/3/2009.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-69 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in

the Appendix to the appellant's brief.

(8) Evidence Relied Upon

7,234,103	Regan	6-2007
2002/0133410	Hermreck	9-2002
2002/0013747	Valentine	1-2002
7,177,829	Wilson	2-2007
5,963,921	Longfield	10-1999
2003/0233296	Wagner	10-2003
2003/0036912	Sobatta	2-2003
6,473,741	Baker	10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under
section 122(b), by another filed in the United States before the invention by the
applicant for patent or (2) a patent granted on an application for patent by
another filed in the United States before the invention by the applicant for patent,
except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application

filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   **Claims 1-6, 8, 12-14, 18-20, 22, 26-29, 32-34, 38-45, 49-60, 62-63, and 67 are rejected under 35 U.S.C. 102(e) as being anticipated by Regan (7,234,103).**

As per claims 1, 14, 20, 28, 32, 33, 40, 51, 52, 54, 53, 55, 56, 57, 58, 59, 62, and 63

Regan teaches a system for processing a tax return, comprising:

an input device that is configured to receive tax information associated with a taxpayer

(See Figure 2, via computer 214), wherein the tax information is in a plurality of media

formats (See col. 5, line 4)(disclosing that multiple documents and document types are

supported)(see also fig. 29, #'s 2900 and 2906)(disclosing documents input in both PDF

and HTML formats);

a format conversion module that is configured to convert the tax information into a

common electronic format (See col. 7 at lines 30-40, via an extract function that

converts the data to a common format for processing);

a data verification module that is configured to determine if the tax information is

sufficient to generate a tax return therefrom (See col. 60 at lines 25-35, via only

accepting digitally signed tax returns);

a tax preparation module that is configured to process the tax information to generate a

tax return if the tax information has been determined to be sufficient (See col. 60 at lines

35-49, via confirmation of information prior to transmission);

a refund options module that is configured to present the taxpayer with options for

receiving value if the taxpayer is entitled to a tax refund, (See col. 1, lines 25-

36)(disclosing that it is well-known that refunds can occur via ECF transfer or by a

mailed check);

a payment options module that is configured to present the taxpayer with options for

paying a tax if the taxpayer owes the tax (See fig. 34)(disclosing that payment can occur

via credit card, electronic check or EFT);

establishing an account with a financial institution if the taxpayer is entitled to a refund,

(See col. 1, lines 25-36)(disclosing the United States Treasury automated clearinghouse

(ACH) system, which establishes transitory bank accounts for refund and payment

processing, and is also a financial institution); and

scanning a least one financial document, (see Regan, fig. 1A #'s 152 and

154)(disclosing retrieving an electronic form from a database and formatting the form,

said formatting being considered a form of scanning).

As per claims 2 and 60, Regan teaches wherein the formats comprise text stored on a

paper-based source document and/or digital information (See Figure 12, via receiving

data from the user for filling the fields utilizing the network 1210).

As per claim 3, Regan teaches wherein receiving the tax information comprises:

downloading the tax information from a repository having at least some of the tax

information stored thereon (See Figure 12, via process step 1208).

As per claim 4, Regan teaches wherein receiving the tax information comprises:

receiving a machine-readable document (electronic or hardcopy) that is completed by

the taxpayer to include at least some of the tax information (See Figure 13, via process

step 1310).

As per claim 5, Regan teaches wherein receiving the tax information comprises:

receiving at least some of the tax information from the taxpayer via an input device (See

Figure 13, via process step 1308).

As per claims 6 and 45, Regan teaches presenting the taxpayer with options for

receiving value if the taxpayer is entitled to a tax refund (See col. 27 at lines 55-60, via

direct repayments to a tax payers nominated account; also see col. 73 at lines 10-15);

and presenting the taxpayer with options for paying a tax if the taxpayer owes the tax

(See col. 25 at lines 45-50, via a taxpayer nominated bank debit account).

As per claims 8, 22 and 34, Regan teaches wherein determining if the tax information is

sufficient to generate a tax return therefrom comprises: evaluating the accuracy of the

tax information (See col. 61 at lines 55-65, via validation and error correction); and

confirming the accuracy of the tax information with the taxpayer (See col. 60 at lines 35-

49, via confirmation of information prior to transmission).

As per claims 12, 26, 38 and 49, Regan teaches providing communication access to a

person who specializes in tax preparation in real time (See col. 15 at lines 50-55, via a

registered tax agent as a user of the system).

As per claims 13, 27, 39 and 50, Regan teaches identifying the taxpayer using

biometrics (See col. 18 at lines 9-15, via securely accessing a network-based tax

service).

As per claim 18, Regan teaches wherein presenting the taxpayer with options for paying

the tax comprises: filing the tax return electronically; and paying the tax via cash,

credit/debit card, and/or an electronic transfer of funds (See col. 25 at lines 45-50, via a

taxpayer nominated bank debit account).

As per claim 19, Regan teaches wherein presenting the taxpayer with options for paying the tax comprises: printing the tax return at the time of preparation for subsequent filing by the taxpayer (See col. 25 at lines 50-60, via print options).

As per claim 29, Regan teaches wherein the account with the financial institution is a conventional bank account (See col. 27 at lines 55-60, via direct repayments to a tax payers nominated bank account).

As per claims 40, 54 and 58, Regan teaches A method of processing a tax return, comprising: receiving tax information associated with a taxpayer; evaluating the accuracy of the tax information (See col. 61 at lines 55-65, via validation and error correction); confirming the accuracy of the tax information with the taxpayer (See col. 60 at lines 35-49, via confirmation of information prior to transmission); processing the tax information to generate a tax return;

a refund options module that is configured to present the taxpayer with options for receiving value if the taxpayer is entitled to a tax refund, (See col. 1, lines 25-36)(disclosing that it is well-known that refunds can occur via ECF transfer or by a mailed check); and

a payment options module that is configured to present the taxpayer with options for paying a tax if the taxpayer owes the tax (See fig. 34)(disclosing that payment can occur via credit card, electronic check or EFT).

As per claim 41, Regan teaches wherein evaluating the accuracy of the tax information comprises: determining if any of the tax information is missing; determining if any of the

tax information is inconsistent (See col. 61 at lines 55-65, via validation and error

correction); determining if any of the tax information is incorrect (See col. 60 at lines 35-

49, via confirmation of information prior to transmission); and/or determining if any of the

tax information is irrelevant.

As per claim 42, Regan teaches querying the taxpayer to obtain new tax information to

remedy any of the missing, inconsistent, and/or incorrect tax information (See col. 61 at

lines 55-65, via checking for and correcting of errors).

As per claim 43, Regan teaches wherein confirming the accuracy of the tax information

comprises: displaying the tax information for the taxpayer; and receiving confirmation

from the taxpayer that the tax information is correct (See col. 60 at lines 35-49, via

confirmation of information prior to transmission).

As per claim 44, Regan teaches wherein the tax information is in a plurality of formats,

the method further comprising: converting the tax information into a common electronic

format (See col. 52 at lines 5-10, via Euro and IRE formats; and also see col. 7 at lines

30-40, via an extract function that converts the data to a common format for

processing).

As per claim 67, Regan teaches wherein the financial transaction is payment of a

personal and/or real property tax (See col. 25 at lines 45-50, via a taxpayer nominated

bank debit account for paying taxes).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   **Claims 10, 11, 24, 25, 36, 37, and 47 are rejected under 35 U.S.C. 103(a) as**

being unpatentable over Regan (7,234,103) in view of Hermreck et al.

(2002/0133410).

As per claims 10, 24, 36 and 47, Regan discloses all elements of the claimed invention,

but fails to explicitly disclose presenting at least one alternative tax strategy to the

taxpayer.

Hermreck et al. discloses a system and method of preparing an income tax return

including presenting at least one alternative tax strategy to the taxpayer (See [0038], via

options for maximizing charitable donations on an income tax return).

From the disclosure of Hermreck it would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify the tax refund system of Regan to

include options for optimizing a tax return as taught by Hermreck et al. in order to attract

customers to the refund system (See [0083] of Hermreck et al.).

As per claims 11, 25, 37 and 48, Regan discloses all elements of the claimed invention,

but fails to explicitly disclose presenting a targeted advertisement to the taxpayer.

Hermreck et al. discloses a system and method of preparing an income tax return

including presenting a targeted advertisement to the taxpayer (See [0083], via a user

presented with an advertisement).

From the disclosure of Hermreck it would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify the tax refund system of

Regan to include targeted advertising as taught by Hermreck et al. in order to attract

customers to the refund system (See [0083] of Hermreck et al.).

4.   **Claims 15, 30, 31, 64, and 65 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Regan (7,234,103) in view of Valentine et al. (2002/0013747).

As per claims 15, 64 and 65, Regan discloses all elements of the claimed invention, but

fails to explicitly disclose dispensing the tax refund to the taxpayer in cash if the tax

refund is below a threshold value; and issuing a check or money order to the taxpayer if

the tax refund is not below the threshold value and/or issuing a government authorized

check to the taxpayer.

Valentine et al. discloses a method and apparatus for electronic filing of income tax

returns by a taxpayer including dispensing the tax refund to the taxpayer in cash if the

tax refund is below a threshold value (See [0026], via a cash refund or a refund

anticipation loan); and

issuing a check or money order to the taxpayer if the tax refund is not below the

threshold value and/or issuing a government authorized check to the taxpayer (See

[0026], via a cashier's check).

As per claims 30 and 31, Regan discloses all elements of the claimed invention, but

fails to explicitly disclose wherein the account with the financial institution is a transitory

bank account for holding a refund anticipation loan; and wherein the account with the

financial institution comprises a savings purse that can only be accessed via a

visit to the financial institution and a spending purse that can be accessed via a debit

card, automatic teller machine (ATM) card, and/or a credit card.

Valentine et al. discloses a method and apparatus for electronic filing of income tax

returns by a taxpayer including wherein the account with the financial institution is a

transitory bank account for holding a refund anticipation loan (See [0025], via a refund

anticipation loan); and wherein the account with the financial institution comprises a

savings purse that can only be accessed via a visit to the financial institution and a

spending purse that can be accessed via a debit card, automatic teller machine (ATM)

card, and/or a credit card (See the Abstract, via a credit card).

From the disclosure of Valentine et al. it would have been obvious to one of ordinary

skill in the art at the time the invention was made to modify the tax refund system of

Regan to include a refund anticipation loan in the form of a debit card as taught by

Valentine et al. in order to quickly receive a tax refund loan (See [0013] of Valentine).

5.   **Claims 16, 17, 46, and 66 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Regan (7,234,103) in view of Wilson et al. (7,177,829).

As per claims 16, 17, 46, and 66, Regan discloses all elements of the claimed invention,

but fails to explicitly disclose wherein presenting the taxpayer with options for receiving

value comprises: filing the tax return electronically; and receiving an instrument of value

associated with a merchant.

Wilson et al. discloses a tax refund system including wherein presenting the taxpayer

with options for receiving value comprises: filing the tax return electronically; and

receiving an instrument of value associated with a merchant (See col. 3 at lines 25- 35,

via a credit or debit card).

From the disclosure of Wilson et al. it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify the tax refund system of Regan

to include receiving an instrument of value as taught by Wilson et al. in order to receive

an instrument of value as payment for a tax return (See col. 1 at lines 45-65 of Wilson et

al.).

6.   Claims 7, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Regan (7,234,103) in view of Longfield (5,963,921).

As per claims 7 and 21, Regan discloses all elements of the claimed invention, but fails

to explicitly disclose establishing an account with a financial institution if the taxpayer is

entitled to a tax refund.

Longfield discloses an electronic income tax refund early payment system with means

for creating of a new deposit account for receipt of an electronically transferred refund

for the IRS including establishing an account with a financial institution if the taxpayer is

entitled to a tax refund (See the Abstract, via creating a deposit account for depositing

an income tax refund).

From the disclosure of Longfield it would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify the tax refund system of

Regan to include creating a deposit account for refund purposes as taught by Longfield

in order to quickly process a tax refund (See col. 1 at lines 45-65 of Longfield).

7.   Claims 9, 23 and 35 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Regan (7,234,103) in view of Wagner (2003/0233296).

As per claims 9, 23 and 35 Regan et al. discloses all element of the claimed invention,

but fails to explicitly disclose wherein determining if the tax information is sufficient to

generate a tax return therefrom comprises: determining if any of the tax information is

irrelevant; and discarding any tax information determined to be irrelevant.

Wagner discloses a system and method for automated form generation and comparison

including determining if any of the tax information is irrelevant; and discarding any tax

information determined to be irrelevant (See [0058], via preventing unwanted data form

being used by the system).

From the disclosure of Wagner it would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify the tax refund system of Regan to

include discarding bad or irrelevant data as taught by Wilson et al. in order to efficiently

capture and process tax data (See [0007] of Wagner).

8.   Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Regan (7,234,103) in view of Sobotta et al. (2003/0036912).

As per claim 61, Regan discloses all elements of the claimed invention, but fails to

explicitly disclose wherein receiving the tax information comprises: scanning the paper-

based source document.

Sobotta et al. discloses a computerized tax transaction system including scanning the

paper-based source document (See [0015], via scanning preprinted forms to retrieve

tax related data).

From the disclosure of Sobotta et al. it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify the tax refund system of Regan

to include scanning tax forms as taught by Sobotta et al. in order to lessen tax data

entry errors (See [0014] of Sobotta et al.).

9.   **Claims 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over Regan (7,234,103) in view of Baker (6,473,741).

As per claims 68-70, Regan discloses a method of processing a tax return, comprising:

a tax filing system including determining if the tax return contains any errors (See col.

59 at lines 55-60, via error detection); and generating an amended tax return if any

errors are determined (See col. 4 at lines 57-65, via offering an option of an amended

return);

presenting any errors that are determined to a taxpayer; and receiving input from the

taxpayer responsive to the presentation of the errors (See col. 59 at lines 55-60, via

returning a form in error to a user);

presenting the taxpayer with options for receiving value if the taxpayer is entitled

to a tax refund, (See col. 1, lines 25-36)(disclosing that it is well-known that refunds can

occur via ECF transfer or by a mailed check);

presenting the taxpayer with options for paying a tax if the taxpayer owes the tax (See

fig. 34)(disclosing that payment can occur via credit card, electronic check or EFT)

However, Regan fails to explicitly disclose scanning a tax return that has been filed with

a revenue authority; and converting information on the tax return into an electronic

format.

Baker discloses a method an system for aggregation and exchange of electronic tax

information including scanning a tax return that has been filed with a revenue authority

(See col. 7 at lines 30-35, via scanning a tax return for data); converting information on

the tax return into an electronic format (See col. 7 at lines 30-35, via scanning a tax

return for data).

From the disclosure of Baker it would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify the tax refund system of Regan to

include processing scanned returns as taught by Wilson et al. in order to receive

processed tax data (See col. 2 at lines 45-65 of Baker).

(10) Response to Argument

1.   As per applicant's argument that Regan fails to disclose a plurality of media

formats, it is submitted that Regan does disclose these features, (See Regan, col. 5,

line 4)(disclosing that multiple documents and document types are supported)(see also

fig. 29, #'s 2900 and 2906)(disclosing documents input in both PDF and HTML formats).

In short, multiple electronic file formats are considered to be a form of multiple media

formats.

2.   As per applicant's argument that Regan fails to disclose a refund options module

that is configured to present the taxpayer with options for receiving value if the taxpayer

is entitled to a tax refund, and a payment options module that is configured to present

the taxpayer with options for paying a tax if the taxpayer owes the tax, it is submitted

that Regan does disclose these features, (See Regan, col. 1, lines 25-36)(disclosing

that it is well-known that refunds can occur via ECF transfer or by a mailed check) (See

fig. 34)(disclosing that payment can occur via credit card, electronic check or EFT).

3.   As per Applicant's argument that Regan fails to disclose an account with a

financial institution if the taxpayer is entitled to a refund, it is submitted that the claimed

account can be considered to be "a transitory bank account", (see Applicant's

Specification, p. 11). Furthermore, Regan discloses the United States Treasury

automated clearinghouse (ACH) system, which establishes transitory bank accounts for

refund and payment processing, and is also a financial institution, (See Regan, col. 1,

lines 25-36).

4.   As per Applicant's argument that Regan fails to disclose scanning a least one

financial document, it is submitted that Regan does disclose these features, (see

Regan, fig. 1A #'s 152 and 154)(disclosing retrieving an electronic form from a database

and formatting the form, said formatting being considered a form of scanning).

5.   The claim limitations "establishing an account with a financial institution if the

taxpayer is entitled to a refund", "a refund options module that is configured to present

the taxpayer with options for receiving value if the taxpayer is entitled to a tax refund",

and "a payment options module that is configured to present the taxpayer with options

for paying a tax if the taxpayer owes the tax" are conditional limitations that do not carry

patentable weight since the limitation is only required if, for example, the predicate

condition of the taxpayer being entitled to a refund is met. In other words, the broadest

reasonable interpretation of the claims does not require the argued limitations. The

claims are replete with similar conditional language and this analysis is applied to those

claims not herein specifically argued by Appellant by reference.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/R. SHAY GLASS/

Examiner, Art Unit 3687

/Matthew S Gart/

Supervisory Patent Examiner, Art Unit 3687

Conferees:

Matthew Gart

SPE, Art Unit 3687

/Matthew S Gart/

Supervisory Patent Examiner, Art Unit 3687

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627